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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,300

03/16/2005

Stephen Edward Methuen Forsey

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23872 7590 08/10/2007

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SCARBOROUGH, NY 10510-9227

EXAMINER

KAYES, SEAN PHILLIP

ART UNIT

PAPER NUMBER

2833

MAIL DATE

DELIVERY MODE

08/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/528,300

Applicant(s)

FORSEY ET AL.

Examiner

Sean Kayes

Art Unit

2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5 and 7 is/are rejected.
- 7) ☒ Claim(s) 3,4 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/16/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Objections***

2. Claims 1 and 7 are objected to, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. The use of the pronoun "they" in claim 1 renders the claim indefinite because it is not clear to what the term refers.
4. The use of the term "the latter" in claim 7 renders it indefinite because it is not clear to what that term refers.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Dubois (US 4389122.)
7. With respect to claim 1 Dubois discloses a chronograph watch movement, including a frame and, carried by said frame:

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- an energy source (207 figure 8),
- a time base (211 figure 8) powered by the energy source,
- a first, going train (117, 119, 121, 123, 125, and 127 figure 3) driven in rotation, in synchronism with the time base, and including a mobile for units of time selected from among the minutes and hours of the current time, and

a chronograph mechanism, which includes:

- a second, chronograph train ({47, 49, 51, 53, 55, and 57 figure 3} and/or {67, 69, 71, 73, and 75 figure 3}), to be driven, upon demand, in synchronism with the time base and including first and second wheels respectively completing one revolution in sixty seconds (67 and 71 figure 3 and 127 figure 3) and one revolution in a time allowing the measured units of time, selected from between the hours and minutes, to be displayed and arranged coaxially with said mobile, said wheels being arranged so that they can carry display means for displaying a measured time,
- a control device (19 figure 1, column 2 lines 12-13, and figure 5 ) for starting and stopping said wheels of the second train, and
- a device for resetting the display means (column 1 lines 43-45), wherein said mechanism further includes switching means arranged such that they can occupy two states, in one of which they connect the second wheel of the chronograph train to the mobile of the going train, such that the display means carried by the second wheel display the unit of current time equivalent to that of the measured time.

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8. With respect to claim 2 Dubois discloses a movement according to claim 1, wherein said unit of current time and said unit of measured time is a minute (7 and 9 figures 1 and 3.)

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-2 and 5-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. US 7232254 in view of Dubois (US 4389122.)

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11. With respect to claim 1 US patent, 7232254, claims a chronograph watch movement, including a frame and, carried by said frame:

- an energy source (energy is inherently required to perform time measurement),
- a time base (line 5 of claim 1) powered by the energy source,
- a first, going train ("current time display means" line 3 claim 1), driven in rotation, in synchronism with the time base, and including a mobile for units of time selected from among the minutes and hours of the current time, and

a chronograph mechanism, which includes:

- a second, chronograph train ("measured time display means" line 4 claim 1), to be driven, upon demand, in synchronism with the time base and including first and second wheels respectively completing one revolution in sixty seconds and one revolution in a time allowing the measured units of time, selected from between the hours and minutes, to be displayed and arranged coaxially with said mobile, said wheels being arranged so that they can carry display means for displaying a measured time,
- a control device (lines 6-7 claim 1) for starting and stopping said wheels of the second train, and
- a device ("a reset device" lines 8-9 claim 1) for resetting the display means,
- wherein said mechanism further includes switching means (lines 6-7 claim 1) arranged such that they can occupy two states, in one of which they connect the second wheel of the chronograph train to the mobile of the going train, such that

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device is locking the control device, and the measured time minutes in the opposite case.

Dubois teaches such a wheel carrying only a minute hand.

At the time of the invention it would have been obvious to one skilled in the art to provide a second wheel carrying only a minute hand, as taught by Dubois. The suggestion or motivation for doing so would be provide a separate wheel for indicating measured minutes as opposed to current time minutes thus allowing the current time to be operated when the measured time is not, as taught by Dubois.

***Allowable Subject Matter***

15. Claims 3, 4, and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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the display means carried by the second wheel display the unit of current time equivalent to that of the measured time.

12. With respect to claim 2 US patent, 7232254, claims a movement according to claim 1.

Wherein said unit of current time and said unit of measured time is a minute is not claimed.

Dubois teaches measuring time in units of a minute.

At the time of the invention it would have been obvious to one skilled in the art to measure time in units of a minute as taught by Dubois. The suggestion or motivation for doing so would be to indicate the measured time in well known units of time.

13. With respect to claim 5 the US patent, 7232254, in view of Dubois discloses a movement according to claim 2, wherein the chronograph mechanism further includes a locking device (lines 9-17 claim 1) arranged for locking the control device while the switching means are connecting the second wheel of the second train to said mobile.

14. With respect to claim 7 the US patent, 7232254, in view of Dubois discloses a movement according to claim 5.

The US patent, 7232254, does not claim wherein only the second wheel carries a minute hand, such that the latter displays the current time minutes while the locking



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Kayes whose telephone number is (571) 272-8931. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Paula can be reached on (571) 272-2800 ext 33. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

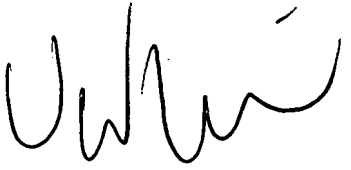
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SK  
8/1/2007



Vit Miska  
Primary Examiner